

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Mark L. Ernest et al.

Application No.: 10/005,862

Confirmation No.: 2036

Filed: November 8, 2001

Art Unit: 3623

For: AUTOMATED INFORMATION  
TECHNOLOGY MANAGEMENT SYSTEM

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Examiner: B. Van Doren

**REPLY BRIEF**

**MS Reply Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

In the Examiner's Answer, mailed December 5, 2008, states a "New Ground(s) of Rejection" in **Section (6)** which is repeated in and added to the previous version of the grounds of rejection found in **Section (9)**. This Reply Brief addresses the new grounds of rejection and the arguments of previously filed Appeal and Reply Briefs address the previous versions of the grounds of rejection found in **Section (9)**. The undersigned request that the points raised in this Reply Brief be considered when considering the newly raised issues of the Examiner's Answer.

In particular, the new grounds of rejection state:

Claims 1-9 are rejected under 35 U.S.C. Section 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Thus, to

qualify as a 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, *or positively recite the subject matter being transformed*, for example by identifying the material that is being changed to a different state (emphasis added).

Here, the components recited in the claims *can merely be software components* (emphasis added). Therefore, applicant's method steps *fail the first prong of the new Federal Circuit decision* since they are not tied to another statutory class and can be performed without the use of a particular apparatus (emphasis added). Thus, it is respectfully submitted that the claims are directed to non-statutory subject matter.

However, as stated above, there is actually a second prong in the test for determining statutory subject matter that follows the "or" clause of:

"positively recite the subject matter being transformed,"

being an indication of statutory subject matter. As discussed below, it is respectfully submitted that the claims do indeed positively recite the subject matter being transformed.

Claim 1 of the application recites:

[a] computerized process for managing an integrated information technology (IT) system having a plurality of components and providing a plurality of services, the process comprising the steps of:

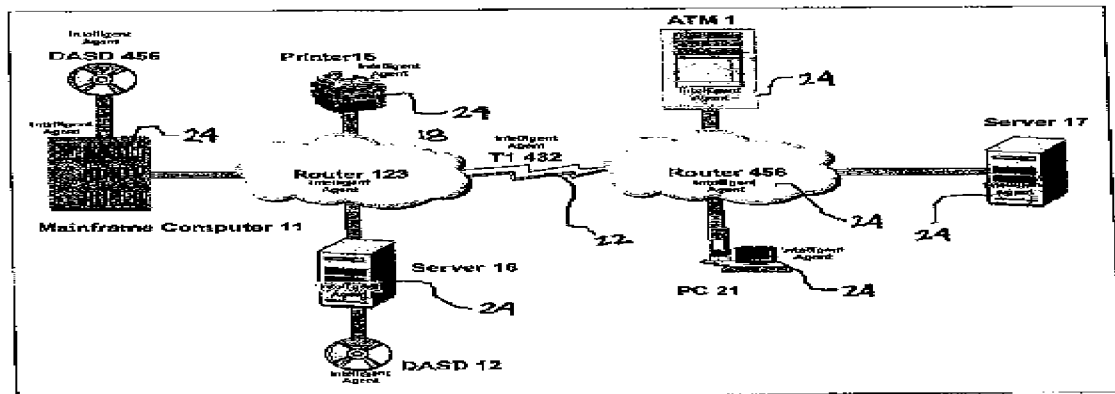
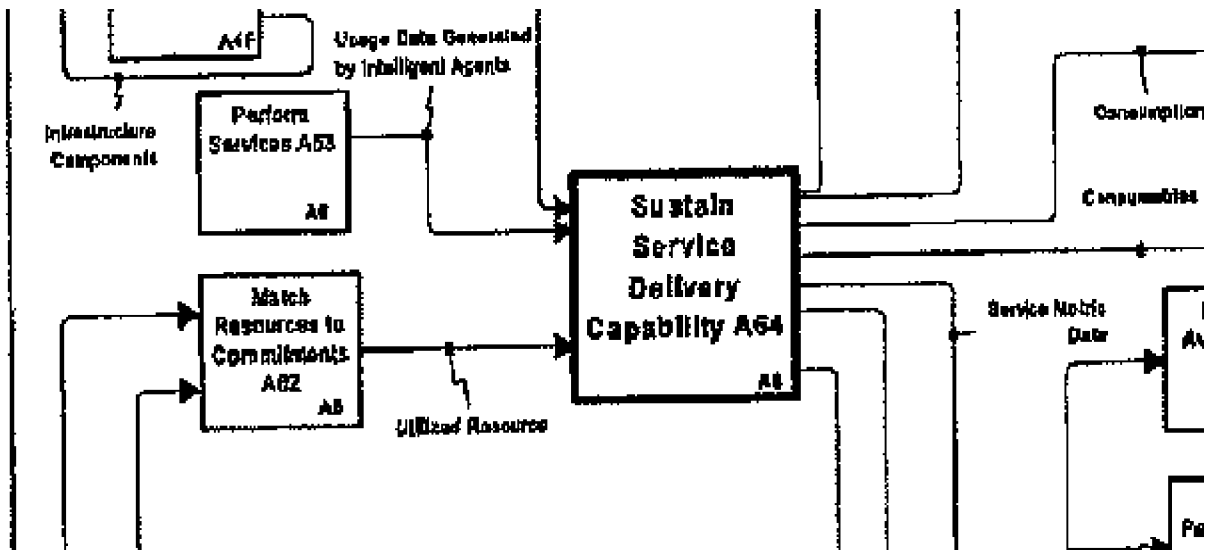
*collecting, at each of the components, usage data* indicating an amount of use each component receives in providing each of the services,

reporting the usage data of each component for each service;

*constructing a valuation function for valuing each service*, correlating each service with each component used to provide said service; and

*determining from said correlated services and components a value of each component* and a value of said IT system (emphasis added).

Support for the limitations of the claims is provided by **FIG. 3** and **FIG. 5**, as shown below. In particular, **FIG. 3** and the specification discloses the IT system includes a mainframe computer **11** that is interconnected with DASD **12**, printer **15**, servers **16-17**, routers **18-19**, data terminals **21** and data transfer device **22** and that each of the components in the IT system includes an intelligent agent **24** which runs on a dedicated processor associated with that component.<sup>1</sup>

**FIGURE 3****FIGURE 5**

<sup>1</sup> U.S. Patent Application Publication No. US 2003/0088456 at **FIG. 3** and paragraph [0089].

In addition, as shown in **FIG. 5** above and the specification disclose that each agent **24** periodically reports accumulated data related to the component on which it is installed to a 'Sustain Service Delivery Capability' process, **A64** and that *accumulates the data from the agents and creates the tables of **FIGS. 2 and 4** various reports regarding (i) the value of each component in the delivery of each service, and (ii) the value of the component to the business enterprise as a whole, based on its multi-service applicability (emphasis added).*<sup>2</sup> That is, "collecting, at each of the components, usage data," as recited in claim 1, corresponds to "accumulates the data from the agents" disclosed by the specification. In addition, the recitation of: "constructing a valuation function for valuing each service" and "determining from said correlated services and components a value of each component" in claim 1 corresponds to:

*creates the tables of **FIGS. 2 and 4** various reports regarding (i) the value of each component in the delivery of each service, and (ii) the value of the component to the business enterprise (emphasis added).*

As a result of the above discussion, it is respectfully submitted that claim 1 is statutory subject matter according to the second prong of the above-discussed test because it:

"positively recite the subject matter being transformed."

That is, the "usage data" of claim 1 is the *subject matter* that is *being transformed* by "constructing a valuation function for valuing each service" and "determining from said correlated services and components a value of each component," as recited in claim 1. Therefore, in response to the new grounds of rejection in the Examiner's Answer, it is respectfully submitted that the claims are indeed statutory subject matter and that the outstanding Section 101 rejection should be withdrawn.

**Previous Rejections under 35 U.S.C. § 101, § 112 and 35 U.S.C. § 102**

The undersigned relies upon the arguments in the previous versions of the Appeal Briefs

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<sup>2</sup> U.S. Patent Application Publication No. US 2003/0088456 at **FIG. 5** and paragraph [0093] and [0094].

and previous versions Reply Briefs filed in this application regarding the remaining issues in the appeal of this case.

Dated: February 5, 2009

Respectfully submitted,

By\_\_\_/Myron Keith Wyche/\_\_\_\_\_  
Myron Keith Wyche, Reg. No. 47,341  
CONNOLLY BOVE LODGE & HUTZ LLP  
1990 M Street, N.W., Suite 800  
Washington, DC 20036-3425  
(202) 331-7111  
(202) 293-6229 (Fax)  
Agent for Applicant